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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,368	03/26/2001	Kazuo Nakada	1466.1034	7332

21171 7590 06/16/2004

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EXAMINER

SCHLAIFER, JONATHAN D

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,368

Applicant(s)

NAKADA ET AL.

Examiner

Jonathan D. Schlaifer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/26/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to application 09/816,368 filed on 3/26/2001, with prior art filed on 3/26/2001.
2. Claims 1-10 are pending in the case. Claims 1, 3, 7, 9, and 10 are independent claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 9 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer program is not embodied on a computer-readable medium.
4. The following is a relevant excerpt from MPEP 2105: (a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se **Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory** because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and

is thus statutory. Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions. Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's

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functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. See paragraph IV.B.2(b), below. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim. See paragraph IV.B.2(a), below

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Brandt et al.**

(USPN 6,603,839 B1—filing date 9/13/2000), hereinafter Brandt

6. **Regarding independent claim 1**, Brandt discloses in col. 4, lines 63-67 and col. 5, lines 1-23 An electronic information delivery system for delivering electronic information to a plurality of users (as noted in lines 1-5 of the Abstract, the invention works by transferring reports via telecommunications services), comprising: an information database for storing the electronic information to be acquired (information is stored in customer databases in col. 1, lines 25-35); a selection information storing portion for storing selection information for each user (information is stored by user in the client databases, lines 25-35), the information being used for selecting necessary information

from the electronic information (informational analysis occurs at col. 2, lines 10-25 via the Global Statistical Engine); an editing portion for searching and editing information necessary for each user using the selection information from the information stored in the information database (user interaction via order entry occurs at col. 2, lines 45-50); a user-edited information storing portion for storing the edited information for each user (given the edited portion at col. 2, lines 45-50, there would inherently be storage involved in the process); and a transmitting portion for transmitting the information stored in the user-edited information storing portion to each user via a network (in figure 3, distribution of the information via an intranet is portrayed).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt, further in view of Reddington (USPN 4,554,631—filing date 7/13/1983).**
8. **Regarding dependent claim 2**, Brandt fails to disclose a system wherein means for assigning a keyword to the electronic information to be stored in the information data are provided, the selection information includes a keyword selected by the user, and the editing portion searches and edits necessary information from the information stored in the information database in accordance with the keyword included in the selection information. However, Reddington, in the Abstract, lines 1-15, details how database

searching can be carried out using keywords to screen information for retrieval purposes in a specific manner. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used keywords in the invention of Brandt in the manner of Reddington since Reddington's feature would have provided the screen information for retrieval purposes in a specific manner.

9. **Claims 3 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt, further in view of Crandall (USPN 5,970,231—filing date 11/27/1996).**
10. **Regarding independent claim 3**, it is identical to claim 1 except that the information which the invention deals with is newspaper information and since Crandall discloses in the Abstract, lines 1-15 the use of an electronic device to disseminate, to organize and regulated the large amounts of data found in a newspaper operation, so it would have been obvious to one of ordinary skill in the art at the time of the invention to use the invention of Brandt, which already satisfies the limitations of claim 1, since Crandall's feature would have allowed organizing and regulating the large-scale amounts of data in an efficient and organized manner (which would have been found in a newspaper operation).
11. **Claim 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt, further in view of Crandall, further in view of Loeb et al. (USPN 6,014,641—filing date 12/11/1996), hereinafter Loeb.**
12. **Regarding dependent claim 4**, Brandt and Crandall fails to disclose a system wherein the selection information includes publisher information that is used for selecting a publisher and page information that is used for selecting a newspaper page, and the

editing portion is structured to edit necessary newspaper information for each of the page information. However, Loeb, in Claim 32 (col. 15, lines 15-20) describes the acquisition and use of publisher information to effectively manage publisher transactions in an organized and uniform manner. Furthermore, Crandall, in col. 6, lines 30-40 describes the use of page information for a newspaper page in order to help guide and regulate the user's acquisition of information from the newspaper page. It would have been obvious to one of ordinary skill in the art at the time of the invention to use in Brandt's invention publisher information as described in Loeb to effectively manage publisher transactions in an organized and uniform manner, and it would have been obvious to one of ordinary skill in the art at the time of the invention to use in Brandt's invention newspaper page information as described in Crandall to help guide and regulate the user's acquisition of information from the newspaper page.

13. **Regarding dependent claim 5**, it is a modification of claim 4 in the same way in which

claim 2 modifies claim 1, and it is rejected under similar rationale.

14. **Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt,**

further in view of Crandall, further in view of Hotti (USPN 6,144,941—filing date 2/24/1998).

15. **Regarding dependent claim 6**, Brandt and Crandall fail to disclose a bulletin database

for storing bulletin information that is published by the publisher, the newspaper

information being transmitted to a user twice at predetermined times in the morning and

in the evening of the current day, and newly-published bulletin information is transmitted

to a user without delay. However, Hotti discloses in col. 5, lines 15-45, a bulletin board

with synchronized transmission of information to update a target destination with up-to-date data. Further, it was notoriously well known in the art at the time of the invention that synchronization at the beginning and end of the day is useful because it coincide with backup needs of the the business cycle. Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Hotti's bulletin board into the inventions of Brandt and Crandall in order to provide up-to-date data for the target data system and incorporate transmissions during the morning and evening because these would coincide with backup needs of the business cycle.

16. **Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt, further in view of Crandall, further in view of Shibata et al. (USPN 5,835,923—filing date 3/14/1996), hereinafter Shibata.**
17. **Regarding dependent claim 7,** it is the same as claim 3 except for the limitations of a plurality of user terminals provided in each user being connected with the newspaper information host system via the network, each of the user terminals including a memory device for story newspaper information received from the newspaper information host system, and a display device for displaying the newspaper information stored in the memory device. Brandt and Crandall fail to disclose these limitations. However, Shibata, in Figure 2, discloses Newspaper On-Demand Terminals in a network that inherently have displays and memories in order to facilitate the dissemination of the newspaper to its audience by increasing its availability. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the network

architecture of Shibata into Brandt and Crandall in order to facilitate the dissemination of the newspaper to its audience by increasing its availability.

18. **Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt, further in view of Crandall, further in view of Shibata, further in view of Van den Heuvel et al. (USPN 5,301,359—filing date 3/9/1993), hereinafter Van den Heuvel.**
19. **Regarding dependent claim 8,** Brandt, Crandall, and Shibata fails to disclose that the display device of the user terminal displays the newspaper information for each page, and the display device displays a message indicating that a new bulletin information is received. However, Van den Heuvel discloses in col. 4, lines 45-65 the use of indicators with bulletin board systems to provide useful feedback about the status of the bulletin board. It would have been obvious to one of ordinary skill in the art at the time of the invention to use indicators in the manner of Van den Heuvel to provide useful feedback about the status of the bulletin board.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 6,212,506 B1 (filing date 9/16/1997)—Shah et al.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D. Schlaifer whose telephone number is 703-305-9777. The examiner can normally be reached on 8:30-5:00, M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS


STEPHEN S. HONG
PRIMARY EXAMINER